

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<p>In Application of:</p> <p>Lester, et al</p> <p>Application No.: 10/021,752</p> <p>Filed: October 29, 2001</p> <p>For: INTERACTIVE DELIVERY OF MEDIA USING DYNAMIC PLAYLIST GENERATION SUBJECT TO RESTRICTIVE CRITERIA</p>	<p>Group Art Unit: 2154</p> <p>Confirmation No. 6272</p> <p>Examiner: M. Siddiqi</p>
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REVISED APPELLANTS' BRIEF

TO THE COMMISSIONER FOR PATENTS:

This communication is submitted in response to the Final Office Action dated April 6, 2006 and the Notice of Appeal filed on October 6, 2006 pertaining to the captioned patent application identified above. Appellants, Lester et al., have previously filed a Notice of Appeal from the action of the Examiner in finally rejecting all of the claims that were considered in this application. This Brief is being filed under the provisions of 37 C.F.R. § 41.37. The Filing Fee corresponding to this Appeal Brief, as set forth in 37 C.F.R. § 41.20(b)(2), was submitted on December 6, 2006.

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In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)

In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981)

FEDERAL STATUTES

35 U.S.C. §103(a)

MPEP

MPEP § 2112

I. REAL PARTY IN INTEREST

The rights of the inventors in this application have been assigned to RealNetworks, Inc. of Seattle, Washington by way of assignment from James P. Lester, and Alexander J. Kirk (“Lester et al.”) who are the named inventors and are captioned in the present brief.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative, and the above-identified assignee are unaware of other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

III. STATUS OF THE CLAIMS

Claims 12-25 were withdrawn. Claims 1-11 and 26-32 are pending. Appellants appeal the rejection of each of these claims.

IV. STATUS OF AMENDMENTS

As requested by the Examiner, a full set of claims as currently entered is attached in Appendix A. These claims include amendments from previously entered amendments requested in filed Office Action responses. These claims represent the latest true and correct version of the claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Claim 1 (and related claims 3-5 and 9-11)

Regarding this independent claim, as currently pending claim 1 recites:

A computer implemented method of delivering digital media items to one or more user electronic devices, the method comprising:

delivering to one or more of the user electronic devices, via a computer network, the digital media items in a sequential order from a playlist, the playlist indicating a plurality of the digital media items to be delivered and the sequential order for their delivery to one or more of the user electronic devices;

receiving one or more requests for at least one digital media item from one or more of the user electronic devices; and

selectively adding an indication of the requested digital media item to the playlist on at least one of the user electronic devices if the modified playlist would satisfy a set of restrictive criteria.

Thus, under pending claim 1 (and dependent claims 3-5 and 9-11), the method recited is directed toward delivering digital media items, i.e., song files, to one or more user electronic devices such that the delivery is done so based on a playlist. The playlist may be interactively modified by users based on both the users' requests subject to a set of restrictive criteria, such as the criteria relating to the Digital Millennium Copyright Act. As a result, actual digital media items requested by actual users may be added to a playlist so long as compliance with the restrictions of the Digital Millennium Copyright Act is maintained.

Claim 1 finds general support in Fig. 3. Specifically, the recitations of Claim 1 find support in the specification as filed as follows. Page 9 lines 3-9 support the recitation, "delivering to one or more of the user electronic devices, via a computer network, the digital media items in a sequential order from a playlist, the playlist indicating a plurality of the digital media items to be delivered and the sequential order for their delivery to one or more of the user electronic devices." Page 10 lines 13-15 supports the recitation, "receiving one or more requests for at least one digital media item from one or more of the user electronic devices." Page 11 lines 12-14 supports the recitation, "selectively adding an indication of the requested digital media item to the playlist on at least one of the user electronic devices if the modified playlist would satisfy a set of restrictive criteria."

Claim 3 find support on Page 15 lines 9-11.

Claim 4 finds support in Fig. 2 and associated text.

Claim 5 finds support on Page 14 lines 4-6.

Page 16 lines 5-10 provides support for the first recitation in Claim 9, "providing a searchable database of media items that allows at least one of the user electronic devices to search the database by a set of media attributes." The remaining recitations in Claim 9 are supported on Page 10 lines 13-15 ("receiving one or more requests for at least one digital media item from one or more of the user electronic devices") and Page 11 lines 12-14 ("selectively adding an indication of the requested digital media item to the playlist on at least one of the user electronic devices if the modified playlist would satisfy a set of restrictive criteria").

Claim 10 is supported by Page 17 lines 1-3.

Claim 11 is supported by Page 8 line 3.

B. Claim 2 and 6-8

Claims 2 and 6-8 depend directly from claim 1 and consequently include all of the recitations discussed above regarding claim 1. These claims include additional recitations regarding the set of restrictive criteria by which digital media file requests are subjected to when added to the playlist. Such additional recitations include group preferences, statutory licensing, and time restrictions.

Claim 2 finds support on Page 13 lines 4-6. Claims 6-8 find support on Page 15 lines 1-5.

C. Claim 26 (and related claims 29-32)

Regarding this independent claim, as currently pending claim 26 recites:

One or more media servers for delivering digital media files to a plurality of client electronic devices over a computer network, the one or more media servers comprising:

- a network connection for communicatively coupling one or more of the media servers with the plurality of client electronic devices over the network;
- a playlist memory containing a playlist, wherein the playlist indicates a sequential order to render a set of the digital media files; a media storage memory containing a library of the digital media files; and
- a processor coupled with the network connection, the playlist memory, and the media storage memory, the processor operative to:
 - evaluate requests for digital media files from one or more of the client electronic devices using a set of restrictive criteria;
 - upon at least one of the requests satisfying the set of restrictive criteria, add an indication of the requested digital media file to the playlist; and
 - transmit digital media files according to the sequential order indicated by the playlist from the media storage memory to the plurality of client electronic devices over the computer network.

Thus, under pending claim 26 (and dependent claims 29-32), the system recited is directed toward a network of devices capable of delivering digital media items, i.e., song files, to one or more user electronic devices such that the delivery is done so based on a playlist. The playlist may be interactively modified by users based on the users' requests subject to a set of restrictive criteria, such as the criteria relating to the Digital Millennium Copyright Act. As a result, actual digital media items requested by actual users may be added to a playlist so long as compliance with the restrictions of the Digital Millennium Copyright Act is maintained.

Claim 26 finds support in the specification as follows: Fig. 3 and associated text (“a network connection for communicatively coupling one or more of the media servers with the plurality of client electronic devices over the network”); Fig. 3, Page 9 lines 3-4 (“a playlist memory containing a playlist, wherein the playlist indicates a sequential order to render a set of the digital media files”); Figs. 1, 3 and associated text (“a media storage memory containing a library of the digital media files”); Fig. 1 and associated text (“a processor coupled with the network connection, the playlist memory, and the media storage memory”); Page 10 line 13- Page 11 line 2 (“evaluate requests for digital media files from one or more of the client electronic devices using a set of restrictive criteria”); Page 11 lines 12-14 (“upon at least one of the requests satisfying the set of restrictive criteria, add an indication of the requested digital media file to the playlist”); Page 12 lines 4-5 (“transmit digital media files according to the sequential order indicated by the playlist from the media storage memory to the plurality of client electronic devices over the computer network”).

Claim 29 finds support on Page 8 line 3.

Claim 30 finds support in Fig. 3 and Page 9 lines 15-17 (“the playlist memory contains a plurality of playlists, each playlist corresponding to a network media channel”); Page 9 lines 15-17 and Page 10 lines 13-15 (“the processor is adapted to receive requests for digital media files from the plurality of client electronic devices, each request being associated with a network media channel”); Page 11 lines 1-2 (“the processor evaluates each request using one or more restrictive criteria”); Page 11 lines 12-14 (“if the playlist including the requested digital media file would satisfy the set of restrictive criteria, adds the requested digital media file to the playlist”); Fig. 1 and Page 12 lines 5-6 (“the one or more media servers broadcast digital media files sequentially to the network on each of the plurality of network media channels according to each corresponding playlist”).

Claim 31 finds support on Page 14 lines 12-16.

Claim 32 finds support on Page 13 lines 4-6.

D. Claim 27 and 28

Claims 27 and 28 depend directly from claim 26 and consequently include all of the recitations discussed above regarding claim 26. These claims include additional recitations regarding the set of restrictive criteria by which digital media file requests may be added to the

playlist. Such additional recitations include group preferences, statutory licensing, and time restrictions.

Claim 27 finds support on Page 14 lines 12-16.

Claim 28 finds support on Page 13 lines 4-6.

VI. GROUND'S OF REJECTION TO BE REVIEWED ON APPEAL

Thus, the issues in the appeal are as follows:

1. Whether U.S. Patent Application 2002/0082901 A1 to Dunning et al. ("*Dunning*") teaches all of the features and recitations as respectively recited by claims 1, 3-5, and 9-11.
2. Whether U.S. Patent Application 2002/0082901 A1 to Dunning et al. teaches all of the features and recitations as respectively recited by claims 2 and 6-8.
3. Whether U.S. Patent Application 2002/0082901 A1 to Dunning et al. teaches all of the features and recitations as respectively recited by claims 26 and 29-32.
4. Whether U.S. Patent Application 2002/0082901 A1 to Dunning et al. teaches all of the features and recitations as respectively recited by claims 27 and 28.

VII. ARGUMENT

The Appellant suggests the following grouping of Claims according to the Issues noted above:

- I. Issue 1 is directed toward pending claims 1, 3-5, and 9-11 such that these claims stand or fall together with respect to this issue.
- II. Issue 2 is directed toward pending claims 2 and 6-8 such that these claims stand or fall together with respect to this issue.
- III. Issue 3 is directed toward pending claims 26 and 29-32 such that these claims stand or fall together with respect to this issue.
- IV. Issue 4 is directed toward pending claims 27 and 28 such that these claims stand or fall together with respect to this issue.

Issue 1: *Dunning*, whether considered alone or in conjunction with any prior art of record fails to teach all of the recitations as respectively recited by claims 1, 3-5, and 9-11.

A1. As to the set of claims corresponding to issue 1, claims 1, 3-5, and 9-11 depend either directly or indirectly from independent claim 1. Thus, claims 3-5 and 9-11 include all of the features and limitations of claim 1, in combination with its own respective features and limitations.

Claims 1, 3-5, and 9-11 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Dunning*. Regarding the independent claim, claim 1 recites:

A computer implemented method of delivering digital media items to one or more user electronic devices, the method comprising:

delivering to one or more of the user electronic devices, via a computer network, the digital media items in a sequential order from a playlist, the playlist indicating a plurality of the digital media items to be delivered and the sequential order for their delivery to one or more of the user electronic devices;

receiving one or more requests for at least one digital media item from one or more of the user electronic devices; and

selectively adding an indication of the requested digital media item to the playlist on at least one of the user electronic devices if the modified playlist would satisfy a set of restrictive criteria.

Thus, under pending claim 1 (and dependent claims 3-5 and 9-11), the method recited is directed toward a novel approach for selectively adding digital media files to a playlist based on a set of restrictive criteria. In specific, the unique approach offers users of electronic devices, such as an Internet-ready radio, the ability to request specific digital media items to be streamed to a user's electronic device while maintaining compliance with restrictive criteria, such as the Digital Millennium Copyright Act. With such a method in place, a user of an electronic device may actively participate in shaping the playlist of a streamed signal received by the user's electronic device. Thus, actual specific user's requests may be added to a streaming playlist if, and only if, the adding of the specific requested digital media item does not violate one or more restrictive criteria.

Resultantly, an Internet-radio station may actively solicit requests from users of the Internet radio station, i.e., user electronic devices that stream the content provided by the Internet-radio station, and actively include one or more requests in one or more modifications of the playlist such that specifically requested digital media items are added to the playlist so long

as the modification of the playlist complies with a set of restrictive criteria. For example, the Digital Millennium Copyright Act specifically allows providers of streaming content to not obtain statutory licenses for the delivery of digital content as long as “fewer than a substantial portion of the programming consists of songs delivered within an hour of the request or at a time specified by the broadcaster.” Therefore, a digital content provider may stream a selection of digital content that includes specifically requested digital media if the specifically requested digital media does not exceed a substantial portion of the overall programming. In but one example, a substantial portion of the programming may be defined as a rate of two requested items per hour.

A2. The most recent Office Action dated April 6, 2006 (“Office Action”) rejected claims 1, 3-5, and 9-11 as being anticipated by *Dunning*. Regarding these rejections, Appellants respectfully disagree on appeal.

A3. In pertinent part, U.S.C. §102(e) recites:

A person shall be entitled to a patent unless: (e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). *See also In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) and MPEP §2112.

A4. A rejection under 35 U.S.C. §102(e) requires the Examiner to show that a prior art reference teaches each and every element in an anticipated claim. Independent claim 1 has been previously amended to direct towards a novel method of modifying a playlist of digital media based on recognition of restrictive criteria. As such, the Office Action contends that *Dunning* teaches:

- A computer implemented method of delivering digital media items to one or more user electronic devices, the method comprising. Page 6 paragraph 91, page 5 paragraph 85, and the abstract of *Dunning* are referenced.
- Delivering to one or more of the user electronic devices, via a computer network, the digital media items in a sequential order from a playlist, the playlist indicating a plurality of the digital media items to be delivered and the sequential order for their delivery to one or more of the user electronic devices. Page 6 paragraph 91, page 5 paragraph 85, page 17 paragraphs 280- 281, page 4 paragraphs 45-46, and page 8 paragraphs 120-121 of *Dunning* are referenced.
- Receiving one or more requests for at least one digital media item from one or more of the user electronic devices. Page 5 paragraphs 85-86 of *Dunning* are referenced.
- Selectively adding an indication of the requested digital media item to the playlist on at least one of the user electronic devices if the modified playlist would satisfy a set of restrictive criteria. Pages 7-8 paragraphs 111-113, page 17 paragraphs 280-281, and page 25 paragraphs 255-256 of *Dunning* are referenced.

Appellants submit that each and every recitation of claim 1 is not disclosed by *Dunning* as contended by the Office Action. This is discussed further below.

A5. The primary cited and applied reference, *Dunning*, discloses a relationship discovery engine to recommend items based on discovered relationships. Specifically, *Dunning* makes recommendations to a user based on a user profile generated using apparent user preferences in accordance with a binomial log likelihood ratio analysis technique. *Dunning* further indicates that this technique may be used to automatically generate track lists for a personalized radio station (see e.g., *Dunning* [0044]-[0049] on page 4). Specific cited sections of *Dunning* are directed to populating a jukebox with digital media content based upon user-associated data such as past media selections and the like. See page 5, [0085]-[0086] of *Dunning*. That is, a software module, often called a jukebox, may stream digital media to a number of connected media players, such as a program running on a user's computer.

A6. *Dunning* does not disclose adding an indication of the requested digital media item to the playlist if the modified playlist would satisfy a set of restrictive criteria as recited in Claim 1. That is, *Dunning* does not teach providing any kind of mechanism or method for allowing the receiving of requests from a user electronic device that may, in turn, modify a playlist received

back at the user electronic device subject to restrictive criteria. *Dunning* may teach a jukebox having automatically generated track lists but limits delivery of this customized playlist to a single user. Thus, although there may be several listeners connected to a jukebox, each listener is provided separate track lists “to be played by the user” (see e.g., *Dunning* [0121] on page 8) and generation of the separate track lists is based on determined preferences of that user “to populate... with music tracks that are likely to appeal to a particular listener,” (*Dunning* [0049] on page 4).

Moreover, there is no indication in *Dunning* that the actual requested digital media items are delivered to the plurality of user electronic devices as recited in claim 1. The digital media items used to populate a playlist in *Dunning* is generated from similar digital media, i.e., items that may likely appeal to a user because other similar items have been selected. Rather, *Dunning* only indicates that the generated track list played on the personalized radio station may be sampled/heard by the primary user whose profile was used to generate the track list (see e.g., “a particular listener” in *Dunning* [0049] on page 4 and “the user” in *Dunning* [0121] on page 8).

For example, in the method of claim 1, a user may request the song “Jumping Jack Flash” by the Rolling Stones. If adding this specific song to the playlist is within restrictive criteria, then this specific song is added to the playlist. *Dunning*, quite differently, may take note that a user has already played the song “Jumping Jack Flash” by the Rolling Stones and add the song “Jumping Jack Flash” by Aretha Franklin to the playlist because they are similar. Thus, in *Dunning*, the “requested” item is not the same item added to the playlist and this is a method that is in direct contrast with the method of claim 1.

A7. *Dunning* does not disclose selectively adding an indication of the requested digital media item to the playlist on at least one of the user electronic devices as recited in claim 1. Further, *Dunning* does not teach or discuss the prophetic reconfiguration of a previously generated playlist in accordance with “a set of restrictive criteria” as recited in claim 1. Specifically, *Dunning* does not show projecting the effect of “selectively adding the requested media item to the playlist” with respect to “satisfying a set of restrictive criteria” as recited in claim 1 of the instant application. Thus, populating a programming block with various segments according to *Dunning* is limited to generating a new track list that is compliant with “heuristic rules for repetition limits and classes of songs” (*Dunning* [0049] on page 4) to automatically generate brand new track lists, rather than modifying a previously available track list with a

proposed/requested “media item” from the user and evaluating whether the modified track list “would satisfy a set of restrictive criteria” as recited in claim 1 of the instant application.

Moreover, *Dunning* is limited to the automatic generation of track lists based on user profiles that are generated “without requiring users to complete questionnaires” (*Dunning* Abstract). In fact, in this respect the passive automatic track list generation of *Dunning* without active user input actually teaches away from the instant invention, where a playlist is constructed by “receiving a request for a media item from one or more of the users” and “selectively adding the requested media item to the play list” so long as the modified playlist would still satisfy “a set of restrictive criteria” as recited in claim 1 of the instant application. Ideally, in the personalized radio station operating in accordance with *Dunning*, the *Dunning* user does not need to (much less, is even allowed to) make any requests because the track lists are automatically generated.

A8. *Dunning* does not disclose receiving one or more requests for at least one digital media item from one or more of the user electronic devices as recited in claim 1. Clearly, *Dunning* does not show delivering to the user electronic devices digital media items as recited in claim 1 of the instant application. Nor does *Dunning* anticipate receiving one or more requests for at least one digital media item from one or more of the user electronic devices and selectively adding the requested digital media item as recited in Claim 1.

A9. In view of the foregoing, the Appellants respectfully submit that the rejections of claims 1, 3-5, and 9-11 must fail for impropriety, and that Board must accordingly overturn these rejections.

Issue 2: Dunning, whether considered alone or in conjunction with any other prior art of record, fails to teach all of the recitations as respectively recited by claims 2 and 6-8.

B1. As to the set of claims corresponding to issue 2, claims 2 and 6-8 depend either directly or indirectly from independent claim 1. Thus, claims 2 and 6-8 include all of the features and limitations of claim 1, in combination with its own respective features and limitations.

Claims 2 and 6-8 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Dunning* with respect independent claim 1. Claim 1 is directed to a novel method for modifying a digital media playlist while maintaining compliance with a set of restrictive criteria. Regarding these rejections, Appellants respectfully disagree on appeal.

B2. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). *See also In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) and MPEP §2112.

B3 A rejection under 35 U.S.C. §102(e) requires the Examiner to show that a prior art reference teaches each and every element in an anticipated claim. Independent claim 1 has been previously amended to direct towards a novel method of the playlist based on recognition of restrictive criteria. Claims 2 and 6-8 recite additional patentable subject matter regarding the nature of the restrictive criteria. For example, claim 2 further recites the restrictive criteria comprises compliance with a set of group criteria. As another example, claim 6 recites additional restrictive criteria wherein delivering digital media items comprises broadcasting media items to one or more of the user electronic devices so that fewer than a substantial number of media items are delivered within an hour of when their corresponding request was received.

B4. The primary cited and applied reference, *Dunning*, discloses only a passing mention of generating new playlists (which is not the same as modifying existing playlists) within limiting legislation so as to comply with the Digital Millennium Copyright Act (see page 4, [0049]), but makes absolutely no further mention of any restrictive criteria, much less restrictions that may affect/modify an existing playlist. Certainly, *Dunning* does not rise to the level of disclosing such criteria as compliance with a set of group criteria or limiting broadcast of digital media so as that fewer than a substantial number of media items are delivered within an hour of when their corresponding request was received. In fact, *Dunning* provides no link between any requested media items and a subjugation to any restrictive criteria. *Dunning* simply does not address the nature of dealing with digital media requests and actual adding the requested digital media to a playlist. At best, *Dunning* discloses adding one or more digital media items to populate a newly generated playlist based upon past user choices or user preferences and specifically not based on any current request from a user.

B5. In view of the foregoing, the Appellants respectfully submit that the rejections of claims 2 and 6-8 must fail for impropriety, and that Board must accordingly overturn these rejections.

Issue 3: Dunning, whether considered alone or in conjunction with any other prior art of record, fails to teach all of the recitations as respectively recited by claims 26 and 29-32.

C1. As to the set of claims corresponding to issue 3, claims 26 and 29-32 depend either directly or indirectly from independent claim 26. Thus, claims 26 and 29-32 include all of the features and limitations of claim 26, in combination with its own respective features and limitations.

Claims 26 and 29-32 have been rejected under 35 U.S.C. § 103(e) as being anticipated by *Dunning*. Regarding the independent claim, claim 26 recites:

One or more media servers for delivering digital media files to a plurality of client electronic devices over a computer network, the one or more media servers comprising:

a network connection for communicatively coupling one or more of the media servers with the plurality of client electronic devices over the network;

a playlist memory containing a playlist, wherein the playlist indicates a sequential order to render a set of the digital media files; a media storage memory containing a library of the digital media files; and

a processor coupled with the network connection, the playlist memory, and the media storage memory, the processor operative to:

evaluate requests for digital media files from one or more of the client electronic devices using a set of restrictive criteria;

upon at least one of the requests satisfying the set of restrictive criteria, add an indication of the requested digital media file to the playlist; and

transmit digital media files according to the sequential order indicated by the playlist from the media storage memory to the plurality of client electronic devices over the computer network.

Thus, under pending claim 26 (and dependent claims 29-32), the system recited is directed toward a novel system for modifying a digital media play list based on user requests while still complying with a set of restrictive criteria. As an example, an Internet-radio station may actively solicit requests from users of the Internet radio station, i.e., user electronic devices that stream the content provided by the Internet-radio station, and actively include one or more

requests in one or more modifications of the playlist such that specifically requested digital media items are added to the playlist so long as the modification of the playlist complies with a set of restrictive criteria. For example, the Digital Millennium Copyright Act specifically allows providers of streaming content to not obtain statutory licenses for the delivery of digital content as long as “fewer than a substantial portion of the programming consists of songs delivered within an hour of the request or at a time specified by the broadcaster.” Therefore, a digital content provider may stream a selection of digital content that includes specifically requested digital media if the specifically requested digital media does not exceed a substantial portion of the overall programming. In but one example, a substantial portion of the programming may be defined as a rate of two requested items per hour.

C2. The most recent Office Action rejected claims 26 and 29-32 as being anticipated by *Dunning*. Regarding these rejections, Appellants respectfully disagree on appeal.

C3. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). *See also In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) and MPEP §2112.

C4. A rejection under 35 U.S.C. §102(e) requires the Examiner to show that a prior art reference teaches each and every element in an anticipated claim. Independent claim 26 has been previously amended to direct towards a novel method of modifying a playlist of digital media based on recognition of restrictive criteria. As such, the Office Action contends that *Dunning* teaches:

- One or more media servers for delivering digital media files to a plurality of client electronic devices over a computer network, the one or more media servers comprising. Page 6 paragraph 91 and page 5 paragraph 85 of *Dunning* are referenced.
- A network connection for communicatively coupling one or more of the media servers with the plurality of client electronic devices over the network. Page 6 paragraph 91 and page 5 paragraph 85 of *Dunning* are referenced.

- A playlist memory containing a playlist, wherein the playlist indicates a sequential order to render a set of the digital media files. Page 4 paragraphs 45-46 and page 17 paragraphs 280-281 of *Dunning* are referenced.
- A media storage memory containing a library of the digital media files. Page 4 paragraphs 45-46 and page 17 paragraphs 280-281 of *Dunning* are referenced.
- A processor coupled with the network connection, the playlist memory, and the media storage memory, the processor operative to evaluate requests for digital media files from one or more of the client electronic devices using a set of restrictive criteria, upon at least one of the requests satisfying the set of restrictive criteria, add an indication of the requested digital media file to the playlist, and transmit digital media files according to the sequential order indicated by the playlist from the media storage memory to the plurality of client electronic devices over the computer network. Page 25 paragraphs 255-256, page 20, paragraph 304, and pages 5-6 paragraphs 85-86 of *Dunning* are referenced.

Appellants submit that each and every recitation of claim 26 is not disclosed by *Dunning* as contended by the Office Action. This is discussed further below.

C5. The primary cited and applied reference, *Dunning*, discloses a relationship discovery engine to recommend items based on discovered relationships. Specifically, *Dunning* makes recommendations to a user based on a user profile generated using apparent user preferences in accordance with a binomial log likelihood ratio analysis technique. *Dunning* further indicates that this technique may be used to automatically generate track lists for a personalized radio station (see e.g., *Dunning* [0044]-[0049] on page 4). Specific cited sections of *Dunning* are directed to populating a jukebox with digital media content based upon user-associated data such as past media selections and the like. See page 5, [0085]-[0086] of *Dunning*. That is, a software module, often called a jukebox, may stream digital media to a number of connected media players, such as a program running on a user's computer.

C6. *Dunning* does not disclose a processor that is operative to evaluate requests for digital media files from one or more of the client electronic devices using a set of restrictive criteria. *Dunning* does not teach providing any kind of mechanism or method for allowing the receiving of requests from a user electronic device that may, in turn, modify a playlist received back at the user electronic device subject to restrictive criteria. *Dunning* may teach a jukebox

having automatically generated track lists but limits delivery of this customized playlist to a single user. Thus, although there may be several listeners connected to a jukebox, each listener is provided separate track lists “to be played by the user” (see e.g., *Dunning* [0121] on page 8) and generation of the separate track lists is based on determined preferences of that user “to populate... with music tracks that are likely to appeal to a particular listener,” (*Dunning* [0049] on page 4).

Moreover, there is no indication in *Dunning* that the actual requested digital media items is delivered to the plurality of client electronic devices as recited in claim 26. The digital media items used to populate a playlist in *Dunning* are generated from similar digital media, i.e., items that may likely appeal to a user because other similar items have been selected. *Dunning* only indicates that the generated track list played on the personalized radio station may be sampled/heard by the primary user whose profile was used to generate the track list (see e.g., “a particular listener” in *Dunning* [0049] on page 4 and “the user” in *Dunning* [0121] on page 8).

For example, in the system of claim 26, a user may request the song “Jumping Jack Flash” by the Rolling Stones. If adding this specific song to the playlist is within restrictive criteria, then this specific song is added to the playlist. *Dunning*, quite differently, may take note that a user has already played the song “Jumping Jack Flash” by the Rolling Stones and add the song “Jumping Jack Flash” by Aretha Franklin to the playlist because they are similar. Thus, in *Dunning*, the “requested” item is not the same item added to the playlist and this is a method that is in direct contrast with the system of claim 26. C7. *Dunning* does not disclose a processor that may, upon at least one of the requests satisfying the set of restrictive criteria, add an indication of the requested digital media file to the playlist as recited in claim 26. Further, *Dunning* does not teach or discuss the prophetic reconfiguration of a previously generated playlist in accordance with “a set of restrictive criteria” as recited in claim 26. Specifically, *Dunning* does not show projecting the effect of “selectively adding the requested media item to the playlist” with respect to “satisfying a set of restrictive criteria.” Thus, populating a programming block with various segments according to *Dunning* is limited to generating a new track list that is compliant with “heuristic rules for repetition limits and classes of songs” (*Dunning* [0049] on page 4) to automatically generate brand new track lists, rather than modifying a previously available track list with a proposed/requested “media item” from the user and evaluating whether the modified track list “would satisfy a set of restrictive criteria.”

Moreover, *Dunning* is limited to the automatic generation of track lists based on user profiles that are generated “without requiring users to complete questionnaires” (*Dunning* Abstract). In fact, in this respect the passive automatic track list generation of *Dunning* without active user input actually teaches away from the instant invention, where a playlist is constructed by “receiving a request for a media item from one or more of the users” and “selectively adding the requested media item to the play list” so long as the modified playlist would still satisfy “a set of restrictive criteria” as recited in claim 26 of the instant application. Ideally, in the personalized radio station operating in accordance with *Dunning*, the *Dunning* user does not need to (much less, even allowed to) make any requests because the track lists are automatically generated.

C8. In view of the foregoing, the Appellants respectfully submit that the rejections of claims 26 and 29-32 must fail for impropriety, and that Board must accordingly overturn these rejections.

Issue 4: *Dunning*, whether considered alone or in conjunction with any other prior art of record, fails to teach all of the recitations as respectively recited by claims 27-28.

D1. As to the set of claims corresponding to issue 4, claims 27-28 depend directly from independent claim 26. Thus, claims 27-28 include all of the features and limitations of claim 26, in combination with its own respective features and limitations.

Claims 27-28 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Dunning*. Claim 26 is directed to a novel system for modifying a digital media play list based on user requests while still complying with a set of restrictive criteria. Regarding these rejections, Appellants respectfully disagree on appeal.

D2. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). *See also In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) and MPEP §2112.

D3. A rejection under 35 U.S.C. §102(e) requires the Examiner to show that a prior art reference teaches each and every element in an anticipated claim. Independent claim 26 has been previously amended to direct towards a novel system for modifying a digital media playlist based

on user request while complying with recognition of restrictive criteria. Claims 27 and 28 recite additional patentable subject matter regarding the nature of the restrictive criteria. For example, claim 28 further recites the restrictive criteria comprises compliance with a set of group criteria.

D4. The primary cited and applied reference, *Dunning*, discloses a mere passing mention of generating new playlists within limiting legislation so as to comply with the Digital Millennium Copyright Act (see page 4 [0049]), but makes absolutely no further mention of any restrictive criteria that may affect an existing playlist. Certainly, *Dunning* does not rise to the level of disclosing such criteria as compliance with a set of group criteria or limiting broadcast of digital media so as that fewer than a substantial number of media items are delivered within an hour of when their corresponding request was received. In fact, *Dunning* provides no link between any requested media items and subjugation to any restrictive criteria. *Dunning* simply does not address the nature of dealing with digital media requests and actual adding the requested digital media to a playlist. At best, *Dunning* discloses adding one or more digital media items to populate a newly generated playlist based upon past user choices or user preferences and specifically not based on any current request from a user.

D5. In view of the foregoing, the Appellants respectfully submit that the rejections of claims 27-28 must fail for impropriety, and that Board must accordingly overturn these rejections.

VIII. SUMMARY

Applicants submit that all pending claims are in condition for allowance. Accordingly, early and favorable action allowing all of the pending claims and passing this application to issue is respectfully requested. Applicants' hereby confirm and acknowledge that all fees required for the filing and review of this appeal brief were paid on December 6, 2006.

Respectfully submitted,
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CLAIMS APPENDIX

1. (Previously Presented) A computer implemented method of delivering digital media items to one or more user electronic devices, the method comprising:

delivering to one or more of the user electronic devices, via a computer network, the digital media items in a sequential order from a playlist, the playlist indicating a plurality of the digital media items to be delivered and the sequential order for their delivery to one or more of the user electronic devices;

receiving one or more requests for at least one digital media item from one or more of the user electronic devices; and

selectively adding an indication of the requested digital media item to the playlist on at least one of the user electronic devices if the modified playlist would satisfy a set of restrictive criteria.

2. (Original) The method of claim 1, wherein the set of restrictive criteria comprises whether the playlist satisfies a set of group preferences.

3. (Original) The method of claim 1, wherein the adding comprises inserting a requested media item at a random position in the playlist.

4. (Original) The method of claim 1, wherein the adding comprises:

attempting to add the requested media item to a position in the playlist so that the modified playlist satisfies the set of restrictive criteria; and

disregarding the request if the requested media item cannot be added to the playlist so that the modified playlist would satisfy the set of restrictive criteria.

5. (Original) The method of claim 4, wherein the set of restrictive criteria comprises whether the playlist complies with the Digital Millennium Copyright Act requirement for obtaining a statutory license.

6. (Previously Presented) The method of claim 1, wherein the delivering media items comprises broadcasting media items to one or more of the user electronic devices so that fewer than a substantial number of media items are delivered within an hour of when their corresponding request was received.

7. (Previously Presented) The method of claim 6, wherein the delivering media items further comprises broadcasting media items to one or more of the user electronic devices so that fewer than a substantial number of media items are delivered at a time that at least one of the user electronic devices who made the request is informed the requested media items will be delivered.

8. (Previously Presented) The method of claim 1, wherein the delivering media items comprises broadcasting media items to one or more of the user electronic devices so that the media items are delivered in compliance with the Digital Millennium Copyright Act requirement for obtaining a statutory license.

9. (Previously Presented) The method of claim 1, further comprising:

providing a searchable database of media items that allows at least one of the user electronic devices to search the database by a set of media attributes;

receiving a request from one or more of the user electronic devices for a media item from the database; and

selectively adding the requested media item from the database to the playlist if the modified playlist would satisfy the set of restrictive criteria.

10. (Previously Presented) The method of claim 1, wherein the adding comprises limiting the number of requests from at least one of the user electronic devices.

11. (Original) The method of claim 1, wherein the media items are sound recordings.

12. (Withdrawn) A computer implemented method of interactively delivering media over a computer network from a media server to a plurality of clients, the method comprising:

generating a playlist that defines a plurality of media files in an order, the playlist satisfying a set of restrictive criteria;

sequentially transmitting the media files as defined by the playlist over the computer network to the clients;

receiving a request for a media file from a client; and

scheduling the requested media file into the playlist if the updated playlist would satisfy the restrictive criteria, whereby the media files are transmitted to the clients according to the updated playlist.

13. (Withdrawn) The method of claim 12, wherein the set of restrictive criteria comprises whether the playlist satisfies a set of group references.

14. (Withdrawn) The method of claim 12, wherein the scheduling comprises adding requested media files into the playlist so that fewer than a substantial number of media files will be transmitted within an hour of retrieving the corresponding request, or at a time that a client is informed that the requested media file will be transmitted.

15. (Withdrawn) The method of claim 14, wherein the scheduling comprises adding requested media files into the playlist so that at least one media file will be transmitted within an hour of receiving the corresponding request.

16. (Withdrawn) The method of claim 12, wherein the media files represent sound recordings.

17. (Withdrawn) The method of claim 12, further comprising:

providing a searchable database of media files, wherein a client can search the database according to a set of media file attributes and request a specific media file therefrom; and

scheduling the requested specific media file into the playlist if the updated playlist would satisfy the set of restrictive criteria.

18. (Withdrawn) The method of claim 12, wherein the media server comprises a computer system having a memory, the method further comprising;

maintaining the playlist in the memory of the media server.

19. (Withdrawn) A computer implemented method of delivering media over a computer network to multiple users comprising:

broadcasting streaming media on a channel according to a broadcasting schedule, wherein multiple users can access the channel and the media broadcasted thereon;

receiving a plurality of requests for media from one or more users; and

incorporating the requested media into the streaming media if doing so would satisfy a set of restrictive criteria.

20. (Withdrawn) The method of claim 19, wherein the broadcasting comprises delivering fewer than a substantial number of requested media within an hour of receiving the corresponding

request, or at a time that the requesting user is informed that the requested media will be broadcast.

21. (Withdrawn) The method of claim 19, wherein streaming media is streaming audio.

22. (Withdrawn) A computer implemented method of delivering media over a computer network from a media provider to multiple users, the method comprising:

- broadcasting a specific program of media on each of a plurality of channels, wherein multiple users can access each channel and thereby receive the program broadcasted thereon;
- receiving from a user a request for media corresponding to one of the channels; and
- incorporating the requested media into the corresponding channel's program if the modified program would satisfy a set of restrictive criteria, the restrictive criteria including a set of channel preferences unique between at least two channels.

23. (Withdrawn) The method of claim 22, wherein the incorporating comprises adding the requested media into the corresponding channel's program so that fewer than a substantial number of media will be broadcasted within an hour of receiving the corresponding request or at a time that a user is informed that the requested media will be broadcasted.

24. (Withdrawn) The method of claim 22, wherein the set of restrictive criteria comprises a requirement that the program only incorporate requests originating from users who have paid a fee to the media provider.

25. (Withdrawn) The method of claim 22, wherein the media is music.

26. (Previously Presented) One or more media servers for delivering digital media files to a plurality of client electronic devices over a computer network, the one or more media servers comprising:

- a network connection for communicatively coupling one or more of the media servers with the plurality of client electronic devices over the computer network;
- a playlist memory containing a playlist, wherein the playlist indicates a sequential order to render a set of the digital media files;
- a media storage memory containing a library of the digital media files; and
- a processor coupled with the network connection, the playlist memory, and the media storage memory, the processor operative to:

evaluate requests for digital media files from one or more of the client electronic devices using a set of restrictive criteria;
upon at least one of the requests satisfying the set of restrictive criteria, add an indication of the requested digital media file to the playlist; and
transmit digital media files according to the sequential order indicated by the playlist from the media storage memory to the plurality of client electronic devices over the computer network.

27. (Previously Presented) The one or more media servers of claim 26, wherein the one or more media servers broadcast fewer than a substantial number of digital media files within an hour of receiving the request for a corresponding digital media file, or at a time that at least one client electronic device is informed that the requested digital media file will be broadcast.

28. (Previously Presented) The one or more media servers of claim 26, wherein the set of restrictive criteria comprise whether the playlist satisfies a set of group preferences.

29. (Previously Presented) The one or more media servers of claim 26, wherein the digital media files are digital sound files.

30. (Previously Presented) The one or more media servers of claim 26, wherein:

the playlist memory contains a plurality of playlists, each playlist corresponding to a network media channel;

the processor is adapted to receive requests for digital media files from the plurality of client electronic devices, each request being associated with a network media channel, wherein the processor evaluates each request using one or more restrictive criteria and, if the playlist including the requested digital media file would satisfy the set of restrictive criteria, adds the requested digital media file to the playlist; and

the one or more media servers broadcast digital media files sequentially to the network on each of the plurality of network media channels according to each corresponding playlist.

31. (Previously Presented) The one or more media servers of claim 30, wherein, for each network media channel, the one or more media servers broadcast fewer than a substantial number of digital media files within an hour of receiving at least one of the requests for the corresponding

digital media file, or at a time that at least one of the client electronic devices is informed that the requested digital media file will be broadcast.

32. (Previously Presented) The one or more media servers of claim 30, wherein the set of restrictive criteria comprises a set of group preferences to each network media channel.

EVIDENCE APPENDIX

NONE.

RELATED PROCEEDINGS APPENDIX

NONE.